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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,690	08/06/1999	MASATO TAKEUCHI	49233-(1117)	7128

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT PAPER NUMBER

2155

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,690

Applicant(s)

TAKEUCHI ET AL.

Examiner

Michael Y. Won

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Amendment filed on August 16, 2005.
2. Claims 1 and 7 have been amended.
3. Claims 1-7 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso (US Pat No.6085201 A).

As per **claim 1**, Tso teaches an information processing (see col.1, lines 4-7) device for transmitting and receiving electronic mail over a transmission line, comprising: a memory means (see Fig.2, #4 and col.3, line 46) for storing answer examples for a reply mail (see col.4, lines 23-24 and col.5, lines 7-9); a contents selecting means for presenting a contents of a received mail and requiring a user to select therefrom at least one or more portions of contents of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15) necessary for preparing a reply to the received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13); a temporary memory means for temporarily storing said one or more portions of contents of said received mail selected by said contents selecting means (see Fig.1, #3 or #4 and col.3, lines 36-38 or lines 49-56); an answer example presentation means for presenting answer examples stored in the temporary memory means (see Fig.3, #233 and col.5, lines 42-48); an answer message selecting means for requiring a user to select any of the answer examples presented by the answer examples presenting means (see Fig.3, #235 and col.5, lines 51-60); and a reply-mail preparing means for preparing a reply mail by coupling said one or more portions stored in said temporary memory means with answer examples selected by the answer message selecting means (see Fig.3; Fig.4; col.6, line 66 to col.7, lines 13; and col.7, lines 28-31), wherein said reply mail includes said at least one or more portions of contents of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15).

As per **claim 2**, Tso further teaches wherein it is further provided with a reply mail setting means for setting a sender of the received mail as an addressee of the reply mail and a receiver of the received mail as an addresser of the reply mail (inherent: see col.4 lines 31-34).

As per **claim 3**, Tso further teaches wherein it is further provided with a reply example preparing means for generating any kinds of answer examples and an answer example adding means for additionally storing the answer examples prepared by the reply example preparing means into the memory means (see col.6, lines 59-63).

As per **claim 4**, Tso teaches a storage medium carrying a program readable by a computer (see col.3, lines 21-28), which program causes the computer to execute the steps of: requiring a user to select at least one or more portions of necessary contents picked from received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13) and storing the contents into a reply contents storage means (see col.6, lines 59-63 and col.7, lines 28-31); presenting candidate answer examples previously stored in a candidate answer storage means and requiring the user to select one of the candidate answer examples (see Fig.3 and col.5, lines 42-48 & 51-60); storing the selected candidate answer into an answer storage means (see col.6, lines 59-63); and preparing reply mail by coupling at least one or more portions of the contents stored in the reply contents storage means with the answer examples stored in the answer storage means and storing the prepared reply mail in a reply mail storage means (see Fig.3; Fig.4; col.6, line 66 to col.7, lines 13; and col.7, lines 28-31),

wherein said reply mail includes said at least one or more portions of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15).

As per **claim 5**, Tso teaches a storage medium carrying a program readable by a computer (see col.3, lines 21-28), which program causes the computer to execute the steps of: requiring a user to select at least one or more portions of necessary contents picked from received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13) and storing the contents into a reply contents storage means (see col.6, lines 59-63 and col.7, lines 28-31); presenting candidate answer examples previously stored in a candidate answer storage means and requiring said user to select one of said candidate answer examples (see Fig.3 and col.5, lines 42-48 & 51-60); storing the selected candidate answer into an answer storage means (see col.6, lines 59-63); preparing reply mail by coupling at least one or more portions of the contents stored in the reply contents storage means with a contents stored in the answer storage means and storing the prepared reply mail in a reply mail storage means (see Fig.3; Fig.4; col.6, line 66 to col.7, lines 13; and col.7, lines 28-31), wherein said reply mail includes said at least one or more portions of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15); and setting a sender of the received mail as an addressee of the reply mail and a receiver of the received mail as an addresser of the reply mail (see claim 2 rejection above).

As per **claim 6**, Tso teaches a storage medium carrying a program readable by a computer (see col.3, lines 21-28), which program causes the computer to execute the steps of: displaying received mail to a user on a screen (see col.4, lines 23-24 and

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col.5, lines 7-9); requiring the user to select at least one or more portions of the necessary contents from the received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13) and storing the contents into a reply contents storage means (see col.6, lines 59-63 and col.7, lines 28-31); presenting candidate answer examples previously stored in a candidate answer storage means on said screen and requiring the user to select one of the candidate answer examples as a selected candidate answer (see Fig.3 and col.5, lines 42-48 & 51-60); storing the selected candidate answer into an answer storage means(see col.6, lines 59-63); and preparing a reply mail by associating at least one or more portions of the contents stored in the reply contents storage means with the answer examples stored in the answer storage means and storing the prepared reply mail in a reply mail storage means (see Fig.3; Fig.4; col.6, line 66 to col.7, lines 13; and col.7, lines 28-31), wherein said reply mail includes said at least one or more portions of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15).

As per **claim 7**, Tso teaches an information processing (see col.1, lines 4-7) device for transmitting and receiving electronic mail over a transmission line, comprising: a screen (see Fig.1, #2) for displaying electronic mail to a user (see col.4, lines 5-12); a memory means (see Fig.2, #4 and col.3, line 46) for storing answer examples for a reply mail (see col.4, lines 23-24 and col.5, lines 7-9); a contents selecting means for displaying the contents of a received mail on said screen and requiring a user to select therefrom at least one or more portions of the contents of said received mail necessary for preparing a reply to the received mail (see Fig.3, #231,

#233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13); a temporary memory means for temporarily storing said one or more portions of contents of said received mail selected by said contents selecting means (see Fig.1, #3 or #4 and col.3, lines 36-38 or lines 49-56); an answer example presentation means for presenting answer examples stored in the temporary memory means (see Fig.3, #233 and col.5, lines 42-48); an answer message selecting means for requiring a user to select any of the answer examples presented by the answer examples presenting means (see Fig.3, #235 and col.5, lines 51-60); and a reply-mail preparing means for preparing a reply mail for display on said screen by associating said one or more portions stored in said temporary memory means with answer examples selected by the answer message selecting means (see Fig.3; Fig.4; col.6, line 66 to col.7, lines 13; and col.7, lines 28-31), wherein said reply mail includes said at least one or more portions of contents of said received mail (see Fig.4; col.2, lines 63-64; and col.6, lines 6-15).

Response to Arguments

5. Applicant's arguments filed August 16, 2005 have been fully considered but they are not persuasive.

In response to the argument regarding the "temporary memory means", although Tso teaches of a mail database, additional reference locations have been provided which teaches of a "template database". In either case, the limitation of "a temporary memory means..." is taught. The limitation teaches "one or more portions of content".

One of ordinary skill in the art would clearly consider the whole e-mail message stored in the database of *Tso* to meet the limitation “more portions of contents” and therefore teaches this limitation.

In response to the argument regarding the use of portions of the received e-mail in the reply e-mail, *Tso* clearly teaches or suggests this limitation. *Tso* teaches that the “template engine” is “context-sensitive” that assists users in composing or replying to email messages using “minimal keyboard access” (see col.2, lines 59-61), therefore one of ordinary skill in the art would concur that a portion or portions of a received text used in generating a response would equate to “minimal keyboard access”. Although the example taught in reference to Figure 4, teaches of “input form identifiers”, *Tso* also teaches that “it is apparent that the template could be used to generate many different text strings” (see col.6, lines 16-20) and teaches of minimizing keystrokes (see col.6, lines 27-31). Furthermore, with reference to Figure 4, *Tso* teaches of a response regarding an email message suggesting to meet with the recipient. It is inherent that when the response message is generated, certain text are re-employed or repeated from the original received message such as “meet”, which clearly teaches the limitation “select therefrom at least one or more portions of contents of said received mail”.

Although, the template of *Tso* may be predefined, one of ordinary skill in the art would similarly suggest that the step of “temporarily storing said one or more portions of contents of said received email selected by said content selecting means” to be used for the presenting and selecting could also be suggested as predefined. The mere fact that the answers are predefined before presentation to the user for selection does not teach

away from employing contents of received mail for the generation of a reply mail. Such teachings are clearly supported in the steps of the recited claim 1 and 7.

For the reasons above and because the language does not patentably teach away from *Tso*, claims 1-7 have been finally rejected.

Conclusion

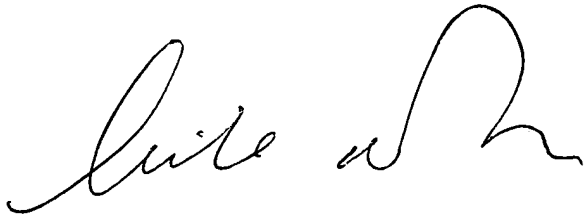
6. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



November 2, 2005



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER